The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY M. GARIBALDI, WALTER M. BLUME
and GERARD H. EPPLIN

Appeal No. 2003-1411
Application 09/292,096

HEARD: APRIL 29, 2004

Before HAIRSTON, KRASS, and RUGGIERO, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 2 through 17.

The disclosed invention relates to a magnetic body located on one end of an endoscope, and to a method of magnetically navigating the endoscope.

Claim 2 is illustrative of the claimed invention, and it reads as follows:

2. A magnetically navigable endoscope system comprising:

an endoscope having a proximal end and a distal end, the distal end having a magnetic body;

an imaging device which transmits an image, associated with the distal end;

a display component for displaying the image;

a magnetic field generating apparatus for generating a magnetic field to move the magnetic body and thus the distal end of the endoscope;

a controller coordinated with the display for controlling the magnetic field generating apparatus to apply a magnetic field to change the position of the magnetic body and thus the position of the distal end of the endoscope, the controller controlling the magnetic field generating apparatus to apply a magnetic field of a specific direction to change the orientation of the magnetic body and thus the orientation of the distal end of the endoscope.

The references relied on by the examiner are:

Hibino et al. (Hibino)	5,060,632	Oct. 29, 1991
Ueda et al. (Ueda)	5,681,260	Oct. 28, 1997
Koninckx	5,899,851	May 4, 1999 (filed Apr. 18, 1996)

Claims 2, 4, 7, 9 and 10 stand rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention.

Claims 2 through 4, 6, 7, 9 and 11 through 17[1] stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ueda.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ueda in view of Hibino.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Ueda in view of Koninckx.

Reference is made to the briefs (paper numbers 15 and 18), an early Office Action (paper number 9), the final rejection (paper number 12) and the answer (paper number 16) for the respective positions of the appellants and the examiner.

OPINION

We have carefully considered the entire record before us, and we will reverse the indefiniteness rejection of claims 2, 4, 7, 9 and 10, sustain the anticipation rejection of claims 2 through 4, 6, 7, 9 and 11 through 17, reverse the obviousness rejection of claim 5 and sustain the obviousness rejection of claim 10.

Turning first as we must to the indefiniteness rejection, the examiner contends (answer, page 3) that the term "display" lacks antecedent basis because the phrase "display component" was

[1] After submission of the brief, the examiner withdrew the anticipation rejection of claim 8 (answer, page 4).

previously recited in claims 2 and 4. Appellants argue (brief, pages 6 and 7) that the term "display" is "an unmistakable reference to the display on the display component," and that "[t]here is nothing unclear or ambiguous to a person of ordinary skill in the art." We agree with the appellants' arguments. When the term "display" is considered in light of the disclosure, and the context in which it is used in the claims, it is perfectly clear what the appellants are seeking to claim. Accordingly, the indefiniteness rejection of claims 2, 4, 7, 9 and 10 is reversed.

Turning to the anticipation rejection of claims 2 through 4, 6, 7, 9 and 11 through 17, we agree with the examiner's findings (paper number 9, page 4) that "Ueda et al. disclose an endoscope (2) having a magnetic body (20), an imaging device (24, 25 or 5), a display component (7), a magnetic field generating apparatus (11), and a controller (45, 50, Fig. 6) . . . moved in two mutually perpendicular directions." With respect to the claimed "orientation of the magnetic body," we agree with the examiner's statement (final rejection, page 3) that "this is the whole purpose of conventional magnetic guiding apparatus--to change the orientation of the distal end of an instrument by applying a directional magnetic field." We additionally agree with the

examiner (final rejection, page 3) that Figure 12 of Ueda is an illustrative example of changing the orientation of the magnetic body as claimed, and that "[t]he fact that Ueda et al. might 'pull' a magnet in a particular direction in certain instances does not differentiate over the . . . limitation but actually supports it." The claimed "magnetic gradient" is nothing more than a changing aligning field in Ueda (Figure 12) that pulls and moves the endoscope in a particular direction (final rejection, page 3). As indicated by the examiner (answer, page 7), "a magnetic field, generated electrically or by permanent magnets, as is done by Ueda et al. will inherently create a magnetic gradient." The claimed "indicia indicating an orientation of the displayed image" reads directly on the "UP" indicia in Ueda (Figure 46; column 26, lines 47 through 51) (paper number 9, page 4).

Appellants' arguments (brief, pages 7 and 9) that Ueda does not teach aligning the field or the device are without merit because claims 2 and 4 on appeal do not recite such a limitation (answer, page 5).

Appellants' arguments (brief, pages 8 and 9) concerning a "magnetic gradient to move the magnetic body" (claims 3 and 4) have been addressed supra, and by the examiner (answer, pages 6

and 7). Briefly stated, if the disclosed and claimed invention applies a magnetic gradient to move the magnetic body, then Ueda's device performs the same task with a like device.

Appellants' arguments (brief, pages 9 through 12) that Ueda does not disclose the claimed "two mutually perpendicular directions" (claims 6, 7, 9 and 15 through 17) is without merit in light of the explanation offered by the examiner (answer, pages 7 through 9) concerning joystick movement in two mutually perpendicular directions that causes the endoscope to move in the same two mutually perpendicular directions.

In view of the foregoing, the anticipation rejection of claims 2 through 4, 6, 7, 9 and 15 through 17 is sustained. The anticipation rejection of claims 11 through 14 is sustained because appellants have not presented any patentability arguments for these claims.

Turning next to the obviousness rejection of claim 5, this rejection is reversed because we agree with the appellants' argument (brief, page 12) that the applied references neither teach nor would have suggested to the skilled artisan a controller "on" the endoscope that is adjacent the proximal end of the endoscope.

Turning lastly to the obviousness rejection of claim 10, we agree with the examiner's conclusion (paper number 9, page 6) that it would have been obvious to one of ordinary skill in the art to apply the display orientation teachings of Koninckx to Ueda "so that the vertically 'up' direction of the image is oriented at the top of the display regardless of the actual orientation of the endoscope (col. 3, lines 53-55)" to thereby "eliminate disorientation or error caused by looking at a non-vertical image."

DECISION

The decision of the examiner rejecting claims 2, 4, 7, 9 and 10 under the second paragraph of 35 U.S.C. § 112 is reversed. The decision of the examiner rejecting claims 2 through 4, 6, 7, 9 and 11 through 17 under 35 U.S.C. § 102(b) is affirmed. The decision of the examiner rejecting claims 5 and 10 under 35 U.S.C. § 103(a) is affirmed as to claim 10, and is reversed as to claim 5. Accordingly, the decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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ERROL A. KRASS) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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JOSEPH F. RUGGIERO)
Administrative Patent Judge)

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BRYAN K. WHEELOCK
HARNESS, DICKEY & PIERCE, P.L.C.
7700 BONHOMME AVENUE
SUITE 400
ST. LOUIS MO 63105